

REMARKS

In accordance with the foregoing, the specification, the drawings, and claims 19 and 29 have been amended. Claims 1-30 are pending, with claims 1, 19, and 23 being independent. No new matter is presented in this Amendment.

Request for Personal Interview

MPEP 707.02 states as follows on MPEP page 700-115:

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner.

The Office Action of August 14, 2008, is the fourth Office Action that has been issued in the present application, not counting the Requirement for Information of October 19, 2007, and the Advisory Action of May 28, 2008. Also, the present application was filed on October 16, 2003, and thus has been pending for more than five years. Accordingly, the applicants hereby request a personal interview with the following people in an effort to resolve all outstanding issues and place the application in condition for allowance:

the Examiner, Nathan E. Price;

the Examiner's supervisor, Supervisory Primary Examiner (SPE) Meng-Ai T. An;

a Primary Examiner with expertise in the technology of the present application should the SPE not have such expertise; and

a Technology Center 2100 Training Quality Assurance Specialist (TQAS) or Workgroup Quality Assurance Specialist (WQAS) who has the authority to resolve the outstanding issues under 35 USC 101.

The undersigned attorney, Randall S. Svihla, will attempt to contact the Examiner to schedule an interview in the near future, but it is respectfully requested that the Examiner contact the attorney to schedule an interview before acting on the present Amendment should the Examiner be ready to act on the present Amendment before an interview has been scheduled.

Errors in the Office Action of August 14, 2008

In paragraph 5 on page 2 of the Office Action of August 14, 2008, the Examiner states "Applicant's arguments filed 05 September 2007 have been fully considered but they are not persuasive" (emphasis added). However, the Office Action of August 14, 2008, was issued in response to the Request for Continued Examination (RCE) and the Amendment Accompanying Request for Continued Examination filed on June 13, 2008, and also considered the arguments presented in the Amendment After Final Rejection of May 13, 2008. Accordingly, it is presumed that the Examiner intended to state that "Applicant's arguments filed 13 May 2008 and 13 June 2008 have been fully considered but they are not persuasive," and it is respectfully requested that the Examiner confirm this in the next Office Action.

In paragraph 6 on page 3 of the Office Action of August 14, 2008, the Examiner states as follows:

Regarding the rejection of claims 19 – 22 under 35 U.S.C. 112, second paragraph, Applicant argues that the claims are not unclear because even if the recited elements of the apparatus can be implemented in software alone, the claim is not limited to software alone. Examiner's position remains that the recited elements of the apparatus can be implemented in software alone. In such embodiments, the structure of the apparatus is not clear, even if other embodiments do include a physical structure. Hardware to execute the software is not recited.

The above statement also appears on page 3 of the Final Office Action of March 13, 2008. However, the statement of the rejection under 35 USC 112, second paragraph, on page 6 of the Office Action of August 14, 2008, does not include claims 19-22. Furthermore, the Examiner did not provide an explanation of a rejection of claims 19-22 in the explanation of the rejection under 35 USC 112, second paragraph, on pages 6-8 of the Office Action of August 14, 2008. Furthermore, it is submitted that the above statement is no longer applicable to claim 19

and claims 20-22 depending therefrom because claim 19 was amended in the Amendment Accompanying Request for Continued Examination of June 13, 2008, to recite "a physical element" in the body of the claim, which has been change to "an electronic component" in this Amendment. Accordingly, it appears that the above statement was included by error in the Office Action of August 14, 2008, and it is respectfully requested that the Examiner confirm this in the next Office Action.

Specification and Drawing Amendments

Paragraph [0020] has been amended to change "be" to "being."

Paragraph [0063] has been amended to change "draws" to "reads."

Paragraph [0073] has been amended to change "draws" to "retrieves," and to change "drawn" to "retrieved."

FIG. 6 has been amended to change "FILES TO BE PRELOAD" in operation 606 to "PRELOADED FILES."

FIG. 8 has been amended to change "DRAWS" in operation 801 to "READS."

FIG. 16 has been amended to change "THERTO" in the label on the line between operations 1603 and 1605 to "THERE TO," and to change "USE OF DESIGNATED MARKUP DOCUMENTS" in operation 1610 to "OF DESIGNATED MARKUP DOCUMENTS IN USE."

Claim Rejections Under 35 USC 112

Claims 23, 24, 29, and 30 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as the invention. This rejection is respectfully traversed.

Claims 23 and 24

The Examiner states as follows on pages 6-8 of the Office Action of August 14, 2008:

Claims 23 – 24 recite the term enhanced navigation "ENAV". The meaning of enhanced navigation "ENAV" is not

clearly defined. Therefore, the claims fail to clearly define the metes and bounds of the claimed subject matter. The term is indefinite because the specification does not clearly define the term.

Applicant appears to be relying on enhanced navigation ENAV being an accepted term with an established definition in the related art. Applicant's response (received 19 December 2007) concedes that the term is not defined in the foreign priority applications (p. 5 ¶1). However, documents cited by Examiner, as well as documents cited by Applicant, indicate that the features supported by enhanced navigation (ENAV) were not clear to those of ordinary skill in the art around the time of Applicant's filing. For example, Taylor et al. (cited by Applicant in response received 19 December 2007) states that the enhanced navigation (ENAV) specification neared completion in middle of 2003 (see ¶ quoted by Applicant on p. 6 of response received 19 December 2007). This is after some of Applicant's claimed foreign priority dates (the earliest of which is 17 October 2002). Additionally, Sharpless (cited by Applicant in response filed 19 December 2007), which was published 30 July 2003, after some of Applicant's claimed foreign priority dates, suggests that version 1.0 of the enhanced navigation (ENAV) specification [sic] was not available at the time of publication (p. 22 last ¶).

Accordingly, it is not clear what metes and bounds are defined by the term "enhanced navigation (ENAV)" in the foreign priority documents or what definition should then be given to its use in the US application.

Examiner has been unable to obtain a copy of the enhanced navigation (ENAV) specification or determine the date it became available to those of ordinary skill in the art. The requirement for information (mailed 19 October 2007) included a requirement for the enhanced navigation (ENAV) specification (item (B(1)(a) and B(1)(b)). It is noted that Applicant's response (received 19 December 2007) indicated that these items were "...unknown to or is not readily available to the applicants and the assignee..." (p. 5 ¶3). Accordingly, the complete metes and bounds of the term "enhanced navigation (ENAV)" appears to have been undefined and undisclosed at least at the time of Applicant's earliest claimed priority date.

For the purpose of examination, the term "enhanced navigation (ENAV)" has been interpreted to mean any functionality related to presentation or reproduction of audio/video content, such as DVD, streaming video and web content.

These comments by the Examiner are repeated from pages 12-14 of the Final Office Action of March 13, 2008, except that the Examiner has changed "ENAV" to "enhanced navigation (ENAV)."

However, it is submitted that the Examiner's comments about some of the foreign priority applications are irrelevant to whether claim 23 and 24 of the present U.S. application are indefinite under 35 USC 112, second paragraph. The Examiner is examining the U.S. application, not the foreign priority applications.

Furthermore, it is submitted that the Examiner has already recognized that the accepted meaning in the art of the term "ENAV" in claims 23 and 24 is "enhanced navigation" in the following statement that appears in paragraph 23 on pages 8 and 9 of the Office Action of June 6, 2007, in the Examiner's explanation of the rejection of original versions of claims 23 and 24 under 35 USC 112, second paragraph:

The term "ENAV" in claims 23 and 24 is used by the claim to mean "enhanced audio and video", while the accepted meaning is "enhanced navigation." See Tsumagari et al. US 20030161615 A1 (¶ 58). The term is indefinite because the specification does not clearly redefine the term.

Tsumagari was published on August 28, 2003, from Application No. 10/372,899 filed on February 26, 2003, claiming the benefit of Japanese Application No. 2002-49749 filed on February 26, 2002.

Furthermore, it is submitted that the meaning "enhanced navigation" of the term "ENAV" in claims 23 and 24 was known to one of ordinary skill in the ENAV art to which the invention of claims 23 and 24 pertains long before the filing date of October 17, 2002, of the earliest foreign priority application of the present application as evidenced by the following passage of J. Taylor et al., *DVD Demystified*, Third Edition, McGraw-Hill Professional, New York, January 31, 2006, ISBN 0071423966, p. 178, that was quoted by the applicants on page 6 of the Response to Requirement for Information Under 37 CFR 1.105 of December 19, 2007, and was referred to by the Examiner in the explanation of the rejection:

WebDVD for the Rest of the World

In December 2000, the DVD Forum created a new ad-hoc group (AH1-12) chaired by InterActual Technologies to develop a specification for WebDVD. The idea was to have a single format for consumer DVD players as well as PCs so that there was more

incentive for Hollywood studios and others to produce enhanced titles. Members of the ad-hoc group spent years developing what became known as the eNav specification (for enhanced navigation). The format uses XHTML, ECMAScript, and other Web-oriented technologies to add highly interactive control of the DVD-Video portion of discs. But, as the specification neared completion in mid 2003, the next-generation formats were coming to fruition. Many companies, particularly the studios, felt that it was better to wait and incorporate eNav into a single new high-definition format. Thus, eNav died, but from its ashes arose the interactive capabilities of the next-generation formats. Most of the advanced interactivity of HD DVD-Video and BD-J grew from work done on the eNav specification.

Thus, the ad-hoc group AH1-12 that developed the ENAV specification was created in December 2000, almost two years before the filing date of October 17, 2002, of the earliest foreign priority application of the present application. It is submitted that the members of this ad-hoc group were necessarily those of ordinary skill in the ENAV art to which the invention of claims 23 and 24 pertains because they were the ones who created the ENAV art in the first place. It is submitted that sometime during the time between the creation of the ad-hoc group in December 2000 and the filing of the earliest foreign priority application of the present application on October 17, 2002, those of ordinary skill in the ENAV art came to use the term "ENAV" in place of the term "enhanced navigation." Accordingly, it was not necessary to define the term "ENAV" in the foreign priority applications of the present application because those of ordinary skill in the art understood that this term means "enhanced navigation."

For at least the foregoing reasons, it is submitted that the meaning of "ENAV" in claims 23 and 24 is in fact clearly defined, such that claims 23 and 24 do in fact clearly define the metes and bounds of the claimed subject matter as required by 35 USC 112, second paragraph.

The above arguments were also presented on pages 23-26 of the Amendment After Final Rejection of May 13, 2008. In response to these arguments, the Examiner states as follows in the Advisory Action of May 28, 2008:

Regarding rejections of claims 23 and 24 under 35 U.S.C. 112, 2nd paragraph, Applicant argues the term "ENAV" was known to those of ordinary skill in the art at the time the Applicant's invention was filed. Although the terms "ENAV" and "enhanced navigation" became known before Applicant's filing dates, it is not clear that the metes and bounds defined by these terms were known to those of ordinary skill in the art at the time Applicant's invention

was filed or in December 2000 as argued. Specifically, the evidence cited by Applicant indicates the specification for ENAV was nearing completion in mid 2003 (see citation at bottom of page 25 of Applicants remarks). The specification was not known in December 2000 if it did not near completion until 2003. Additionally, Bush et al. (see PTO-892 mailed 19 October 2007) specifically states that the features of ENAV were not known (see 4th search result in reference W on PTO-892 mailed 19 October 2007 for a date of Bush et al). Therefore, although the terms "ENAV" and "enhanced navigation" became known before Applicant's filing dates, it is not clear that the metes and bounds defined by these terms were known to those of ordinary skill in the art at the time Applicant's invention was filed or in December 2000 as argued.

However, it is submitted that that the Examiner's statement that "[t]he specification was not known in December 2000 if it did not near completion until 2003" and the question of whether or not the metes and bounds defined by the terms "ENAV" and "enhanced navigation" were known to those of ordinary skill in the art "at the time Applicant's invention was filed or in December 2000 as argued" are irrelevant to the rejection of claims 23 and 24 under 35 USC 112, second paragraph, which is based on the Examiner's position that "[t]he meaning of 'ENAV' is not clearly defined."

Due to an inadvertent error that occurred during the preparation of the present application, claims 23 and 24 as originally filed recited "an enhanced audio video (ENAV) buffer," rather than "an enhanced navigation (ENAV) buffer." In the Office Action of June 6, 2007, the Examiner took the position that the recitation of "an enhanced audio video (ENAV) buffer" in original claims 23 and 24 was inconsistent with the accepted meaning of the term "ENAV" in the art, which is "enhanced navigation." Accordingly, in the Amendment of September 5, 2007, the applicants amended claims 23 and 24 to recite "an enhanced audio video (ENAV) buffer." Then, in the Final Office Action of March 13, 2008, the Examiner took his current position that the meaning of the term "ENAV" is not clearly defined, such that claims 23 and 24 fail to clearly identify the metes and bounds of the invention, because the term is indefinite because the specification does not clearly define the term.

However, for at least the reasons discussed above and on pages 23-26 of the Amendment After Final Rejection of May 13, 2008, it is submitted that the meaning "enhanced navigation" of the term "ENAV" in claims 23 and 24 was known to one of ordinary skill in the ENAV art to which the invention of claims 23 and 24 pertains long before the filing date of

October 17, 2002, of the earliest foreign priority application of the present application. It is submitted that an U.S. patent application need not define the meaning of a term if the meaning of that term was known to one of ordinary skill in the art at the time the U.S. patent application was filed, as is the case here with the term "ENAV."

With respect to the Examiner's statement that "Bush et al. (see PTO-892 mailed 19 October 2007) specifically states that the features of ENAV were not known (see 4th search result in reference W on PTO-892 mailed 19 October 2007 for a date of Bush et al.)," the Examiner is apparently referring to the paper by Michael Bush et al. entitled "Customized Video Playback: Standards for Content Modeling and Personalization," which appears in the fourth search results in reference W referred to by the Examiner with the notation "for IEEE paper - September 9, 2002," and to the following paragraph on page 5 of that paper:

The DVD Forum (<http://www.dvdforum.org/forum.shtml>) is working on a specification for advanced consumer electronics DVD players called ENAV (Enhanced NAVigation). At this point it is unclear exactly what features will be included in ENAV and whether it will be based on an HTML+ECMAScript or a SMIL model, but it will hopefully include some support for CVP.

However, this passage merely states that it is unclear exactly what features will be included in ENAV. It does not state that it is unclear what the term "ENAV" itself means. Rather, this passage specifically states that the term "ENAV" means "Enhanced NAVigation," thereby establishing that the meaning of this term recited in claims 23 and 24 was known to one of ordinary skill in the art at least as early as September 9, 2002. Assuming *arguendo* that this passage may arguably be interpreted to imply that the ENAV specification evolved over time, it is submitted that this does not make claims 23 and 24 indefinite merely because they recite "an enhanced audio video (ENAV) buffer." Virtually all standards evolve over time. Thus, for example, if the Examiner's position were correct, any claim reciting the term "DVD" in an application filed before the latest version of the DVD standard was completed would be indefinite because that latest version of the DVD standard had not been completed when the application was filed. It is submitted that nothing whatsoever in the statutes, rules, MPEP, or case law supports the position taken by the Examiner. However, should the Examiner repeat the rejection, it is respectfully requested that the Examiner identify some basis in the statutes, rules, MPEP, or case law that supports his position.

The above arguments were also presented on pages 22-24 of the Amendment Accompanying Request for Continued Examination of June 13, 2008. In response to these arguments, the Examiner states as follows on pages 3-5 of the Office Action of August 14, 2008:

Applicant disputes the rejection of claims 23 and 24 under 35 U.S.C. 112, second paragraph. It is noted that Applicant initially argued that ENAV had a specific meaning (apparently other than enhanced audio video) in the art in arguments filed 09 March 2007, but did not identify that specific meaning. The best possible specific meaning that Examiner found for ENAV was "enhanced navigation" (see Office Action mailed 06 June 2007). The information requirement mailed 19 October 2007 clarified that this was the only specific meaning Examiner found in the art for ENAV other than enhanced audio video as disclosed by Applicant's disclosure. In response to the information requirement (19 December 2007), Applicant indicated ENAV means enhanced navigation.

Regarding rejections of claims 23 and 24 under 35 U.S.C. 112, 2nd paragraph, Applicant argues the term "ENAV" was known to those of ordinary skill in the art at the time the Applicant's invention was filed. Although the terms "ENAV" and "enhanced navigation" became known before Applicant's filing dates, it is not clear that the metes and bounds defined by these terms were known to those of ordinary skill in the art at the time Applicant's invention was filed or in December 2000 as argued. Specifically, the evidence cited by Applicant indicates the specification for ENAV was nearing completion in mid 2003 (see citation at bottom of page 25 of Applicants remarks). The specification was not known in December 2000 if it did not near completion until 2003. Additionally, Bush et al. (see PTO-892 mailed 19 October 2007) specifically states that the features of ENAV were not known (see 4th search result in reference W on PTO-892 mailed 19 October 2007 for a date of Bush et al). Therefore, although the terms "ENAV" and "enhanced navigation" became known before Applicant's filing dates, it is not clear that the metes and bounds defined by these terms were known to those of ordinary skill in the art at the time Applicant's invention was filed or in December 2000 as argued.

Therefore, use of the phrase "enhanced navigation (ENAV)" in the claims renders the claims unclear. If Applicant believes that the metes and bounds defined by enhanced navigation (ENAV) are clear, it is requested that Applicant explain the metes and bounds defined by enhanced navigation (ENAV). Although Applicant has provided references that indicate the terms had been used prior to filing of the application and the general context in which the terms are used, the supplied references do

not indicate the metes and bounds defined by enhanced navigation (ENAV).

However, it is submitted that these comments by the Examiner do not directly take note of all of the arguments on pages on pages 22-24 of the Amendment Accompanying Request for Continued Examination of June 13, 2008, which are repeated above, and answer the substance of them as required by MPEP 707.07(f). Accordingly, it is respectfully requested that the Examiner take note of all of these arguments and answer the substance of them in the next Office Action if he repeats the rejection.

In particular, the Examiner has not identified some basis in the statutes, rules, MPEP, or case law that supports his position that "the phrase 'enhanced navigation (ENAV)' in the claims renders the claims unclear" because "it is not clear that the metes and bounds defined by these terms were known to those of ordinary skill in the art at the time Applicant's invention was filed or in December 2000 as argued" as requested at the bottom of page 24 of the Amendment Accompanying Request for Continued Examination of June 13, 2008. Accordingly, it is respectfully requested that the Examiner identify such a basis in the next Office Action if he repeats the rejection.

In any event, it is submitted that the metes and bounds defined by the phrase "enhanced navigation (ENAV)" in claims 23 and 24 were in fact known to those of ordinary skill in the art at least by the time the present application was filed on October 16, 2003, as evidenced, for example, by the attached copy of G. Sharpless, *DVD-Video: Format & Features*, Deluxe Global Media Services, Southwater, West Sussex, UK, July 30, 2003, pp. 21 and 22, Section 5.5, "DVD-ROM Content and Internet Access," and Section 5.5, "Advanced Interactive Features." A copy of page 22 of Sharpless was submitted with the Response to Requirement for Information Under 37 CFR 1.105 of December 19, 2007, and is discussed on page 7 of that Response, although the page number is incorrectly listed as 126 on page 7 of the Response. However, the page number is correctly listed as 22 in the List of References Cited listing Sharpless, p. 22, that was attached to the Response of December 19, 2007.

A List of References Cited by Applicant listing Sharpless, pp. 21 and 22, is attached hereto. It is respectfully requested that the Examiner provide a copy of this List of References Cited by Applicant initialed, signed, and dated by the Examiner to indicate that Sharpless, pp. 21 and 22, has been considered with the next Office Action. Also, it is respectfully requested that

the Examiner provide a copy of the List of References Cited by Applicant listing Sharpless, p. 22, that was attached to the Response of December 19, 2007, with a line drawn through the listing of this reference and initialed, signed, and dated by the Examiner to indicate that the other cited references have been considered with the next Office Action to prevent Sharpless from being listed twice in the References Cited section of any patent that may issue from the present application.

In particular, Sharpless, pp. 21 and 22, states as follows in pertinent part:

5.4. DVD-ROM Content and Internet Access

An increasing number of DVD-Video discs include additional content that can only be used when played on a DVD-equipped PC. A popular example is providing Internet access so that the user can obtain additional information relevant to the content on the disc. The result is that the high quality and bandwidth of DVD can be combined with the latest updates from the Internet. This helps to extend the life of the product, encourage additional use and offers the content owner to promote additional products to the user.

There are two ways that this can be achieved.

1. Links to websites can be used to access a website from a DVD-Video menu. These links will not be accessible when played on a DVD player.
2. HTML code can be used to play the video on the DVD-Video disc. This code can be on the disc or on the website.

Examples include unlocking and playing otherwise hidden content on the disc, playing of video with additional graphics and text from the website and reusing the video for different applications.

5.5. Advanced Interactive Features

The DVD Forum has been working on adding interactive features to DVD players and discs so that, for example, Internet access does not rely only on using a PC.

The additional content on DVD-Video discs to enable interactive features is called Enhanced Navigation (ENAV). This additional content must allow existing players to play the DVD-Video disc and is stored on a DVD-ROM 'zone' on the disc and, optionally, on a web server. The ENAV content can be played back by suitably equipped players as well as PCs. New DVD players will therefore be available that will play the

ENAV contents from the disc and from a web server via a dial-up or broadband connection.

Thus, according to Sharpless, enhanced navigation (ENAV) provides the interactive features described in Sharpless, and accordingly it is submitted that a mode in which these interactive features are provided is an interactive mode. It is submitted that the above description in Sharpless of the interactive features provided by enhanced navigation (ENAV) is consistent with the description of the interactive features provided in the interactive mode in at least paragraphs [0003], [0004], [0048], and [0061] of the specification of the present application as originally filed, which read as follows:

[0003] Interactive DVDs having markup documents to reproduce content thereof in an interactive mode are being commercialized in the market. Generally, content recorded on an interactive DVD is reproduced in two different modes. One of the two modes is a video mode, in which the content is displayed in the same manner as that of data recorded on a general DVD. The other mode is an interactive mode, in which the content is displayed through a display window defined by markup documents of the interactive DVD.

[0004] Where a user selects an interactive mode, a web browser installed in a DVD player displays the markup documents recorded on the interactive DVD. Content selected by the user is displayed through the display window defined by the mark-up documents. For example, where the content is a movie title, a movie is displayed in the display window on a screen, and various pieces of additional information, for example, the scenario, synopsis, and actors' and actresses' photos, may be displayed on the rest of the screen. Such additional information includes image files or text files.

....

[0048] FIG. 3 shows an apparatus for reproducing data from a data storage medium that carries out a preloading or deleting operation with respect to markup documents. The apparatus supports an interactive mode, in which an AV data stream is reproduced from the data storage medium, for example, a DVD 300, by decoding AV data recorded on the DVD 300 and then displaying the decoded data in a display window defined by markup documents. The apparatus includes a reader 1, a first memory 2, a second memory 3, an AV decoder 4, and a presentation engine 5. During an interactive mode, an AV screen is displayed while being embedded in a markup screen. The markup documents are displayed in the markup screen, and the AV screen is obtained by reproducing the AV data.

....

[0061] The reader 1 reads AV data, corresponding to the HTML document read in the operation 601, from the DVD 300 and stores the read AV data in the first memory 2, which is a buffer memory, in operation 604. The AV decoder 4 decodes AV data stored in the first memory 2 into an AV data stream in operation 605. In operation 606, the presentation engine 5 reads the preloaded files from the second memory 3 and displays the decoded AV data stream in a display window, which is defined by the HTML document read by the reader 1 in the operation 601.

In the explanation of the rejection of claims 23 and 24 under 35 USC 112, second paragraph, on page 8 of the Office Action of August 14, 2008, the Examiner states as follows:

For the purpose of examination, the term "enhanced navigation (ENAV)" has been interpreted to mean any functionality related to presentation or reproduction of audio/video content, such as DVD, streaming video and web content.

However, it is submitted that the Examiner's interpretation of the meaning of the term "enhanced navigation (ENAV)" is improper because it is inconsistent with the interactive functions provided by enhanced navigation (ENAV) as described in Sharpless as discussed above, and with the interactive features that are provided by the interactive mode as described in the specification of the present application as discussed above.

For at least the foregoing reasons, it is submitted that the metes and bounds defined by the term "enhanced navigation (ENAV)" in claims 23 and 24 were in fact known to those of ordinary skill in the art at least by the time the present application was filed on October 16, 2003, such that claims 23 and 24 are not indefinite as alleged by the Examiner.

Claims 29 and 30

The Examiner states as follows on page 8 of the Office Action of August 14, 2008:

Claim recites the limitation "physical element" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is not clear if Applicant intended this claim to be dependent on claim 1 or 19. Claim 29 will be treated as dependent on claim 19 for the remainder of this Office Action. Claim 30 inherits this deficiency.

Claim 29 was in fact intended to depend from claim 19, which recited "a physical element," and accordingly has been amended to depend from claim 19, thereby eliminating the lack of antecedent basis problem identified by the Examiner in claim 29 and claim 30 depending therefrom. However, it is also noted that claims 19 and 29 have been amended to change "physical element" to "electronic component."

Conclusion—Claim Rejections Under 35 USC 112

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 23, 24, 29, and 30 under 35 USC 112, second paragraph, be withdrawn.

Claim Rejections Under 35 USC 101

Claims 19-22 have been rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner states as follows on page 8 of the Office Action of August 14, 2008:

It is not clear that the recited physical element renders the apparatus statutory. Specifically, it is not clear what the element is, such that it could be a piece of paper with source code printed on it.

Although the propriety of the Examiner's position is not conceded, independent claim 19 has been amended to change "physical element" to "electronic component." Thus, claim 19 now recites "[a]n apparatus comprising: an electronic component" It is submitted that such an apparatus is unquestionably statutory under 35 USC 101, such that claim 19 and claims 20-22 depending therefrom are now unquestionably directed to statutory subject matter under 35 USC 101.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 19-22 under 35 USC 101 as being directed to non-statutory subject matter be withdrawn.

Claim Rejections Under 35 USC 102

Claims 1-3, 6, 8-15, 17, 25, 26, and 28 have been rejected under 35 USC 102(b) as being anticipated by Sullivan et al. (Sullivan) ("Programming with the Java Media Framework"). This rejection is respectfully traversed.

Claim 1

It is submitted that Sullivan does not disclose the following features of independent claim 1:

An apparatus for reproducing audio video (AV) data using a markup document in an interactive mode selected by a user of the apparatus, comprising:

a buffer to buffer the markup document to enable the apparatus to reproduce the AV data in the interactive mode selected by the user; and

a buffer manager to manage the buffer to preload the markup document and output buffering state information of the buffer in response to a report signal, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user.

The Examiner states as follows on page 9 of the Office Action of August 14, 2008:

As to claim 1, Sullivan teaches an apparatus for reproducing audio video (AV) data using a markup document in an interactive mode selected by a user of the apparatus, comprising:

a buffer to buffer the markup document to enable the apparatus to reproduce the AV data in the interactive mode selected by the user (p. 33 ¶2; p. 75 ¶1 – 2; p. 78 ¶1 – 3; p. 79 ¶1 – 3; p. 95 ¶1 – 2; p. 97 last ¶; p. 177 last ¶); and

a buffer manager to manage the buffer to preload the markup document and output buffering state information of the buffer in response to a report signal, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user (p. 95 ¶1 – p. 96 ¶5).

Unfortunately, this explanation is not very helpful in advancing the prosecution of the application because it forces the applicants to speculate about how the Examiner is interpreting Sullivan. For example, the Examiner has not identified the elements in the numerous portions of

Sullivan he has relied on that the Examiner considers to correspond to the "markup document" and the "AV data" recited in claim 1. Furthermore, the Examiner has not explained why he considers the numerous portions of Sullivan he has relied on to disclose an "interactive mode selected by [a] user" and "reproducing the AV data in the interactive mode selected by the user" as recited in claim 1. It is not seen where the portions of Sullivan relied on by the Examiner contain the term "interactive mode," or describe anything that may reasonably be considered to be an "interactive mode selected by [a] user." Accordingly, should the Examiner repeat the rejection in the next Office Action, it is respectfully requested that the Examiner provide a more detailed explanation of the rejection clarifying these points.

Page 33 of Sullivan relied on by the Examiner is from Chapter 4 entitled "Java Media Player Fundamentals." Pages 75, 78, and 79 of Sullivan relied on by the Examiner are from Chapter 9 entitled "JMF Applets for the Web." Pages 95 and 97 of Sullivan relied on by the Examiner are from Chapter 10 entitled "Monitor Media Data Download." Page 177 of Sullivan relied on by the Examiner is from Chapter 14 entitled "Extending JMF to Support a New Protocol."

Page 29 ¶1 of Sullivan (not relied on by the Examiner) states that "[t]he purpose of the Java Media Player API is to control and present time-based media streams." Page 33 ¶2 of Sullivan relied on by the Examiner states that "[t]he CachingControl object monitors the Player's progress in downloading media data." Page 34 ¶3 of Sullivan (not relied on by the Examiner) states that "[i]t is assumed that Players are implementations for streams that have audio and visual renderers," and that "[t]he Player interface provides methods for view and controlling the audio and video clips." Page 75 ¶1 of Sullivan relied on by the Examiner states that "[y]ou can enhance a website by adding audio and video to the web pages." Page 77 ¶2 of Sullivan (not relied on by the Examiner) states that "[t]he applet can play back any file type that is supported by the Java Media Framework runtime;" that "[t]o play an AVI file, simply set the applet's filename parameter to *yourfile.avi*;" and that "[t]o play an MPEG-1 file, set the filename parameter to *yourfile.mpg*." Page 82 ¶2 of Sullivan (not relied on by the Examiner) states that "[t]he Java Media Framework makes it easy to build multimedia Java applets;" that "[t]he VideoApplet can be used to enhance web pages with video;" that "[t]he ScriptableMediaApplet is an example of how applets can be combined with JavaScript on a web page;" and that "[t]he JarAudioApplet efficiently adds background music to web pages." Page 95 ¶1 of Sullivan relied on by the Examiner states that "[t]he process can include all of the following tasks: thread

creation, memory buffer allocation, loading data into buffers, acquisition of system-dependent resources, connection to a remote server, and download of media data from the network;" that "the download of media data is usually the most time consuming;" and that "[t]he Java Media Player API was designed so that the download of the media data occurs asynchronously." Page 95 ¶2 of Sullivan relied on by the Examiner, which includes the heading "Media Data Download Event Notification," states that "[o]bjects that need to track the progress of the data download should implement the ControllerListener interface to receive notification of caching state changes," and that "[t]he Player notifies all registered listeners of caching state changes by sending a CachingControlEvent." Page 95 ¶3 and page 96 ¶1-4 of Sullivan (not relied on by the Examiner) states that "[t]he CachingControl provides information about the progress of the media data download," and that "[a] CachingControl has five methods: . . . isDownloading . . . getContentLength . . . getContentProgress . . . getProgressBarComponent . . . getControlComponent." Page 100 last ¶ of Sullivan (not relied on by the Examiner) states that "[m]edia data download is a time-consuming process;" that "[m]edia files can be very large, which means that the user may have to wait before a file is ready to play;" and that "[t]hrough the use of the CachingControl and the progress bar, an application can provide feedback to the end user." Page 177 last ¶ of Sullivan relied on by the Examiner states that "[w]hen the Player posts a PrefetchCompleteEvent, it indicates that the Player has reached the prefetched state," and that "[i]n response to the event, the applet calls Player.start to start media playback."

It is submitted that it is readily apparent from the above portions of Sullivan that Sullivan relates to downloading and playing back audio and video data, like the "audio video (AV) data" recited in claim 1. Furthermore, assuming *arguendo* that these portions of Sullivan may arguably be considered to disclose a buffer to buffer the AV data, and a buffer manager to manage the buffer to preload the AV data and output buffering state information of the buffer in response to a report signal, it is submitted that nothing whatsoever in these portions of Sullivan or any other portion of Sullivan discloses or suggests "a buffer to buffer the markup document to enable the apparatus to reproduce the AV data in the interactive mode selected by the user" as recited in claim 1, or "a buffer manager to manage the buffer to preload the markup document and output buffering state information of the buffer in response to a report signal, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user" as recited in claim 1.

Page 75 of Sullivan relied on by the Examiner and pages 76 and 77 of Sullivan not relied by the Examiner disclose a Java applet known as VideoApplet that plays a video file that can be added to a web page. Pages 78 and 79 of Sullivan relied on by the Examiner disclose an applet known as ScriptableMediaApplet that plays a video file that can be added to a web page, and is designed to be scriptable by JavaScript. Both the VideoApplet and the ScriptableMediaApplet have a parameter "controlpanel" that determines whether or not a VCR control panel should be displayed on the web page. Page 79 ¶1 of Sullivan states that "[o]n a web page, it is easy to add HTML FORM buttons that start and stop the video."

Pages 75-79 of Sullivan disclose examples of code that can be used to add the VideoApplet, the ScriptableMediaApplet, and the HTML FORM buttons to a web page. Assuming *arguendo* that this code may arguably be considered to be a "markup document" as recited in claim 1, it is submitted that nothing whatsoever on pages 75-79 of Sullivan or in any portion of Sullivan discloses or suggests that the code is buffered in a buffer, or that a buffer manager manages such a buffer to preload the code and output buffering state information of the buffer in response to a report signal. Accordingly, it is submitted that Sullivan does not disclose "a buffer to buffer the markup document to enable the apparatus to reproduce the AV data in the interactive mode selected by the user" as recited in claim 1, or "a buffer manager to manage the buffer to preload the markup document and output buffering state information of the buffer in response to a report signal, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user" as recited in claim 1.

Although the Examiner has not explained why he considers the numerous portions of Sullivan he has relied on to disclose an "interactive mode selected by [a] user" and "reproducing the AV data in the interactive mode selected by the user" as recited in claim 1, the Examiner states as follows on page 5 of the Office Action of August 14, 2008, with respect to claims 23 and 24:

Regarding teaching of an interactive mode by Sullivan, viewing interactive web pages teaches selecting the interactive mode (p. 78 ¶2; p. 79 ¶1 – 3).

The Examiner of the present application, Nathan E. Price, is also the Examiner of copending Application No. 10/686,537, which has the same specification and drawings as the present application. On page 3 of the Final Office Action of July 2, 2008, issued in copending Application No. 10/686,537, the Examiner states as follows:

Applicant's arguments regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. Applicant argues Sullivan fails to teach a user making a selection as claimed. However, the user selects to use the browser and what to view with the browser (p. 78 ¶ 2 – 3; p. 79 ¶ 1 – 3; Fig. 9.2). The user can control the media and browser, making the environment interactive. This interpretation appears to be consistent with the specification (¶ 6,82).

The Examiner is apparently referring to paragraphs [0006] and [0082] of U.S. Patent Application Publication No. 2004/0139395, which is a publication of copending Application No. 10/686,537, which correspond to paragraphs [0004] and [0060] of the specification of the present application as originally filed, which is in the image file wrapper of the present application.

Paragraph [0004] of the specification as originally filed corresponding to paragraph [0006] of the publication reads as follows (emphasis added):

[0004] Where a user selects an interactive mode, a web browser installed in a DVD player displays the markup documents recorded on the interactive DVD. Content selected by the user is displayed through the display window defined by the mark-up documents. For example, where the content is a movie title, a movie is displayed in the display window on a screen, and various pieces of additional information, for example, the scenario, synopsis, and actors' and actresses' photos, may be displayed on the rest of the screen. Such additional information includes image files or text files.

Paragraph [0060] of the specification as originally filed corresponding to paragraph [0082] of the publication reads as follows (emphasis added):

[0060] FIG. 6 illustrates a method of reproducing data from a data storage medium. In operation 601, the reader 1 reads an HTML document, which is a markup document recorded on the DVD 300, from the DVD 300 where an interactive mode is selected. In operation 602, the presentation engine 5 interprets preload information included in the HTML document and requests that the reader 1 or an Internet server preload files. In response to the request, files to be preloaded are stored in the second memory 3 in operation 603.

Thus, paragraphs [0004] and [0060] of the specification as originally filed disclose that the user selecting the interactive mode causes other things to happen, i.e., causes a web

browser installed in a DVD player to display the markup documents recorded on the interactive DVD as described in paragraph [0004], and causes the reader 1 to read an HTML document, which is a markup document recorded on the DVD 300, from the DVD 300 as described in paragraph [0060].

In contrast, under the Examiner's interpretation of Sullivan, the user selecting "to use the browser and what to view with the browser" causes the interactive mode to be selected. This interpretation is consistent with the Examiner's statement that "[t]he user can control the media and browser, making the environment interactive."

Thus, under the Examiner's interpretation of Sullivan, the selecting of the interactive mode is a result of something else, whereas in paragraphs [0004] and [0060] of the specification as originally filed, the selecting of the interactive mode is a cause of something else, which is the opposite of what happens under the Examiner's interpretation of Sullivan. Thus, the Examiner's interpretation of Sullivan is not in fact consistent with paragraphs [0004] and [0060] of the specification as originally filed as alleged by the Examiner.

Pages 75-70 of Sullivan teach a programmer how to add video to a web page using VideoApplet or ScriptableMediaApplet, and how to display a VCR control panel or HTML FORM buttons to stop and start the video on the web page to enable a user to control playback of the video. Pages 75-79 of Sullivan do not teach the programmer how to give the user the option of selecting an interactive mode. If the programmer chooses to display the VCR control panel or the HTML FORM buttons to start and stop the video on the web page, then the user will be able to control playback of the video. If the user does not want to have the VCR control panel or the HTML FORM buttons to start and stop the video displayed on the web page, there is absolutely no way for the user to turn off the display of the VCR control panel or the HTML FORM buttons to start and stop the video on the web page. If the programmer chooses not to display the VCR control panel or the HTML FORM buttons to start and stop the video on the web page, the user will not be able to control playback of the video. The user has absolutely no control over whether the VCR control panel or the HTML FORM buttons to start and stop the video will be displayed when the user opens the web page. Furthermore, before the user opens a web page, there is absolutely no way for the user to know whether the web page will display the VCR control panel or the HTML FORM buttons to start and stop the video when it is opened. If the web page does not display the VCR control panel or the HTML FORM buttons to start and stop

the video after the user opens the web page, there is absolutely no way for the user to turn on the display of the VCR control panel or the HTML FORM buttons to start and stop the video on the web page. In fact, before the user opens a web page, there is absolutely no way for the user to know whether the programmer has added a video to the web page using VideoApplet or ScriptableMediaApplet. If the user discovers that the programmer has not added a video to the web page after the user opens the web page, there is absolutely no way for the user to add a video to the web page.

It is submitted that in order for a user to be able to select an interactive mode, the user must be given the ability to select the interactive mode. However, it is submitted that pages 75-79 do not teach the programmer how to give the user the ability to select an interactive mode.

The Examiner's theory appears to be that a user selecting to use a browser and selecting what to view with the browser will result in the user selecting an interactive mode if what the user happens to select to view with the browser is a web page to which a programmer has added a video using VideoApplet or ScriptableMediaApplet and has specified that the VCR control panel or the HTML FORM buttons to start and stop the video are to be displayed on the web page as described on pages 75-79 of Sullivan. However, this alleged "selection" of the interactive mode will occur purely by chance. What the user actually selects is to use a browser and what to view with the browser. If the user wants to select the interactive mode, there is absolutely no way for the user to do so, because there is absolutely no way for the user to know in advance which web pages will display the VCR control panel or the HTML FORM buttons to start and stop the video when they are opened. Thus, all the user can do is to keep opening web pages at random until the user happens to find one that displays the VCR control panel or the HTML FORM buttons to start and stop the video when it is opened. Accordingly, it is submitted that the Examiner's interpretation that this random process somehow provides the feature "an interactive mode selected by a user of the apparatus" recited in claim 1 is an unreasonable interpretation that is contrary to how this feature would be interpreted by one of ordinary skill in the art.

Accordingly, for at least the foregoing reasons, it is submitted that Sullivan does not disclose "a buffer to buffer the markup document to enable the apparatus to reproduce the AV data in the interactive mode selected by the user" as recited in claim 1, or "a buffer manager to manage the buffer to preload the markup document and output buffering state information of the

buffer in response to a report signal, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user" as recited in claim 1.

Conclusion—Claim Rejections Under 35 USC 102

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-3, 6, 8-15, 17, 25, 26, and 28 (i.e., claim 1 discussed above and claims 2, 3, 6, 8-15, 17, 25, 26, and 28 depending directly or indirectly therefrom) under 35 USC 102(b) as being anticipated by Sullivan be withdrawn.

Claim Rejections Under 35 USC 103

Rejection 1

Claims 4, 5, 7, 16, 18-22, 27, 29, and 30 have been rejected under 35 USC 103(a) as being unpatentable over Sullivan. This rejection is respectfully traversed.

Claims 4, 5, 7, 16, 18, and 27

Although the propriety of the Examiner's position as set forth on pages 13-15 of the Office Action of August 14, 2008, is not conceded, it is submitted that claims 4, 5, 7, 16, 18, and 27 depending directly or indirectly from claim 1 are patentable over Sullivan for at least the same reasons discussed above that claim 1 is patentable over Sullivan.

Claim 19

The Examiner states as follows on page 15 of the Office Action of August 14, 2008:

As to claim 19, see the rejection of claims 1 and 5. The physical element is inherent when implementing disclosure of Sullivan.

However, it is submitted that Sullivan does not disclose or suggest the following features of independent claim 19 for at least the same reasons discussed above that Sullivan does not disclose the similar features of claim 1:

An apparatus for controlling a buffer to buffer a markup document to reproduce audio video (AV) data in an interactive mode selected by a user of the apparatus, the apparatus comprising:

an electronic component;

a buffer manager to manage the buffer to preload the markup document to enable the apparatus to reproduce the AV data in the interactive mode selected by the user, and output information of the buffer comprising buffering information of the markup document;

wherein the buffering information is used by the apparatus in reproducing the AV data in the interactive mode selected by the user and comprises:

information indicating that preloading of the markup document has succeeded;

information indicating that the preloading of the markup document has failed; and

information indicating that the preloading of the markup document is still being conducted.

Conclusion—Rejection 1

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 4, 5, 7, 16, 18-22, 27, 29, and 30 (i.e., claims 4, 5, 7, 16, 18, and 19 discussed above and claims 20-22, 29, and 30 depending directly or indirectly from claim 19) under 35 USC 103(a) as being unpatentable over Sullivan be withdrawn.

Rejection 2

Claim 23 has been rejected under 35 USC 103(a) as being unpatentable over Kanazawa et al. (Kanazawa) (U.S. Patent No. 6,580,870) in view of Sullivan. This rejection is respectfully traversed.

It is submitted that Kanazawa and Sullivan do not disclose or suggest the following features recited in independent claim 23:

An apparatus for recording and/or reproducing audio video (AV) data using a markup document in an interactive mode

selected by a user of the apparatus before the apparatus reproduces any of the AV data, comprising:

- an AV buffer to buffer the AV data;
- an AV reproduction engine to decode the AV data;
- an enhanced navigation (ENAV) buffer to preload the markup document before the apparatus reproduces any of the AV data to enable the apparatus to reproduce the AV data in the interactive mode selected by the user;
- an ENAV engine to identify buffering state information of the markup document and decode the markup document, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user; and
- an I/O manager to obtain the markup document.

The Examiner has relied on the apparatus shown in FIG. 16 of Kanazawa which displays a Web link button while reproducing DVD video showing a car as shown in FIG. 19A of Kanazawa. If the user clicks on the Web link button, the apparatus displays HTML contents providing information about the car as shown in FIG. 19B of Kanazawa. Assuming *arguendo* that the mode shown in FIGS. 19 A and 19B of Kanazawa may be considered to an interactive mode selected by a user of the apparatus as recited in claim 23, it is submitted that this interactive mode is not selected by the user before the apparatus reproduces any of the AV data as recited in claim 23 because the apparatus in FIG. 16 is already reproducing DVD video as shown in FIG. 19A before the user clicks on the Web link button.

The above arguments were also presented on pages 31 and 32 of the Amendment Accompanying Request for Continued Examination of June 13, 2008. In response to these arguments, the Examiner states as follows on page 5 of the Office Action of August 14, 2008:

Regarding rejections of claims 23 and 24 under 35 U.S.C. 103, Applicant argues Kanazawa fails to teach selecting the interactive mode before any AV data is reproduced. The argued limitation is interpreted as there being AV data not reproduced before selecting the interactive mode, rather than no AV data is reproduced before the selection. If Applicant believes the limitation should be interpreted as no AV data is reproduced before the selection, then it is respectfully requested that Applicant indicate where support for the limitation can be found in the original disclosure.

It is not understood exactly what the Examiner is trying to say in his statement that "[t]he argued limitation is interpreted as there being AV data not reproduced before selecting the interactive mode, rather than no AV data is reproduced before the selection," and it is respectfully requested that the Examiner clarify this statement in the next Office Action if he should repeat the rejection.

Furthermore, the applicants did not argue that "Kanazawa fails to teach selecting the interactive mode before any AV data is reproduced" as alleged by the Examiner. Rather, the applicants argued that Kanazawa's alleged interactive mode "is not selected by the user before the apparatus reproduces any of the AV data as recited in claim 23 because the apparatus in FIG. 16 is already reproducing DVD video as shown in FIG. 19A before the user clicks on the Web link button." The phrase "any of the AV data" in this argument refers back to the "audio video (AV) data" recited in the preamble of claim 23 in the phrase "[a]n apparatus for recording and/or reproducing audio video (AV) data using a markup document in an interactive mode selected by a user of the apparatus before the apparatus reproduces any of the AV data."

This feature is shown, for example, in FIG. 12 of the present application, which shows an example of what happens after a user selects an interactive mode as described, for example, in paragraph [0004] of the specification of the present application. As shown in FIG. 12 and described, for example, in paragraph [0068] of the specification, the markup documents STARTUP.HTM and #4 A.HTM shown in FIG. 1 are preloaded before the apparatus reads any of the AV data #1 AV DATA, #2 AV DATA, #3 AV DATA, #5 AV DATA, and #6 AV DATA shown in FIG. 1. The markup documents STARTUP.HTM and #4 A.HTM are not preloaded until after the user has selected the interactive mode because they are not used in the video mode referred to in paragraph [0003] of the specification, which is the other mode the user can select, and the AV data #1 AV DATA, #2 AV DATA, #3 AV DATA, #5 AV DATA, and #6 AV DATA cannot be reproduced until after they have been read. Accordingly, it is submitted that the features "an interactive mode selected by a user of the apparatus before the apparatus reproduces any of the AV data" and "an enhanced navigation (ENAV) buffer to preload the markup document before the apparatus reproduces any of the AV data to enable the apparatus to reproduce the AV data in the interactive mode selected by the user" are supported by the original disclosure of the present application.

The Examiner states as follows with respect to Sullivan in paragraph 67 on pages 22 and 23 of the Final Office Action of March 13, 2008:

Kanazawa fails to specifically teach an ENAV buffer which preloads the markup document as claimed. However, Sullivan teaches an enhanced navigation (ENAV) buffer which preloads the markup document to reproduce the AV data in the interactive mode; and an ENAV engine which identifies buffering state information of the markup document and decodes the markup document [p. 75 ¶ 1 – 2; p. 78 ¶ 1 – 3; p. 95 ¶ 1 – p. 96 ¶ 4; p. 97 last ¶; p. 177 last ¶; p. 33 ¶ 2; p. 45 ¶ 2]. It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine these teachings because Kanazawa teaches downloading web content in a multimedia environment and Sullivan teaches details of the types of web content and how the content is delivered and presented.

However, it is submitted that Sullivan does not disclose "an ENAV buffer" and "an ENAV engine" as recited in claim 23 as the term "ENAV" would be understood by one of ordinary skill in the ENAV art. Furthermore, the Examiner has not identified where Sullivan discloses "an interactive mode" as recited in claim 23.

The above arguments were also presented on page 32 of the Amendment Accompanying Request for Continued Examination of June 13, 2008. In response to these arguments, the Examiner states as follows on page 5 of the Office Action of August 14, 2008:

In rejecting claims 23 and 24 under 35 U.S.C. 112, second paragraph, Examiner provided an interpretation of enhanced navigation (ENAV). Applicant has not disputed the interpretation, but argues one of ordinary skill in the art would have understood ENAV to mean something other than what is disclosed by Sullivan. Additionally, Applicant has not indicated what one of ordinary skill in the art would have understood enhanced navigation ENAV to mean. Although Applicant has provide references that indicate the terms had been used prior to filing of the application and the general context in which the terms are used, the supplied references do not indicate the metes and bound defined by enhanced navigation (ENAV).

Page 75 of Sullivan discloses a Java applet known as VideoApplet that plays a video file. Page 78 of Sullivan discloses an applet known as ScriptableMediaApplet that plays a video file, and is designed to be scriptable by JavaScript. Both VideoApplet and ScriptableMediaApplet have a parameter "controlpanel" that determines whether or not a VCR control panel should be

displayed. Page 79 of Sullivan states that "[o]n a web page, it is easy to add HTML FORM buttons that start and stop the video." Assuming *arguendo* that these portions of Sullivan may be considered to disclose "an interactive mode" as recited in claim 23, it is submitted that this interactive mode is not "an interactive mode selected by a user of the apparatus before the apparatus reproduces any of the AV data" as recited in claim 23 because a user of the apparatus has no control over whether the VCR control panel is displayed or the HTML FORM buttons that start and stop the video are provided. Rather, this decision is made by the programmer.

Pages 33, 45, 75, 78, 95-97, and 177 of Sullivan relied on by the Examiner explain how a programmer can write code to download and play a video file, and explains how the code accomplishes this. However, a user of the code does not select an interactive mode. Any such selection is made by the programmer.

The above arguments were also presented on pages 32 and 33 of the Amendment Accompanying Request for Continued Examination of June 13, 2008. In response to these arguments, the Examiner states as follows on page 5 of the Office Action of August 14, 2008:

In rejecting claims 23 and 24 under 35 U.S.C. 112, second paragraph, Examiner provided an interpretation of enhanced navigation (ENAV). Applicant has not disputed the interpretation, but argues one of ordinary skill in the art would have understood ENAV to mean something other than what is disclosed by Sullivan. Additionally, Applicant has not indicated what one of ordinary skill in the art would have understood enhanced navigation ENAV to mean. Although Applicant has provided references that indicate the terms had been used prior to filing of the application and the general context in which the terms are used, the supplied references do not indicate the metes and bound defined by enhanced navigation (ENAV).

Regarding teaching of an interactive mode by Sullivan, viewing interactive web pages teaches selecting the interactive mode (p. 78 ¶2; p. 79 ¶1 – 3).

The interpretation of "enhanced navigation (ENAV)" provided by the Examiner appears on page 14 of the Final Office Action of March 13, 2008, and on page 8 of the Office Action of August 14, 2008, where the Examiner states as follows:

For the purpose of examination, the term "enhanced navigation (ENAV)" has been interpreted to mean any functionality related to presentation or reproduction of audio/video content, such as DVD, streaming video and web content.

However, it is submitted that the Examiner's interpretation of the meaning of the term "enhanced navigation (ENAV)" is improper because it is inconsistent with the interactive functions provided by enhanced navigation (ENAV) as described in Sharpless as discussed above in connection with the rejection of claims 23 and 24 under 35 USC 112, second paragraph, and with the interactive features that are provided by the interactive mode as described in the specification of the present application as discussed above in connection with the rejection of claims 23 and 24 under 35 USC 112, second paragraph. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness with respect to claim 23 because the rejection is based on an incorrect interpretation of the term "enhanced navigation (ENAV)."

Also, it is submitted that the Examiner's statements that "Applicant has not indicated what one of ordinary skill in the art would have understood enhanced navigation ENAV to mean" and that "the supplied references do not indicate the metes and bound defined by enhanced navigation (ENAV)" are no longer applicable since these issues have been addressed above in the discussion of the rejection of claims 23 and 24 under 35 USC 112, second paragraph.

With respect to the Examiner's statement "[r]egarding teaching of an interactive mode by Sullivan, viewing interactive web pages teaches selecting the interactive mode (p. 78 ¶12; p. 79 ¶1 – 3)," it is submitted that Sullivan does not disclose or suggest "an interactive mode selected by a user of the apparatus" as recited in claim 23 for at least the same reasons discussed above that Sullivan does not disclose the same feature of claim 1.

As recognized by the Examiner, Kanazawa does not disclose "an enhanced navigation (ENAV) buffer to preload the markup document before the apparatus reproduces any of the AV data to enable the apparatus to reproduce the AV data in the interactive mode selected by the user" as recited in claim 23, or "an ENAV engine to identify buffering state information of the markup document and decode the markup document, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user" as recited in claim 23. However, the Examiner considers these features of claim 23 to be taught by Sullivan. However, it is submitted that Sullivan does not disclose or suggest these features of claim 23 for at least the same reasons discussed above that Sullivan does not disclose the similar features of claim 1.

For at least the foregoing reasons, it is respectfully requested that the rejection of claim 23 under 35 USC 103(a) as being unpatentable over Kanazawa in view of Sullivan be withdrawn.

Rejection 3

Claim 24 has been rejected under 35 USC 103(a) as being unpatentable over Kanazawa and Silberschatz, Avi, Peter Galvin, and Greg Gagne (Silberschatz) ("Applied Operating System Concepts," First Edition, John Wiley & Sons, Inc., 2000, pp. 65-66 and 412-431). This rejection is respectfully traversed.

Although the propriety of the Examiner's position as set forth on page 17 of the Office Action of August 14, 2008, is not conceded, it is submitted that claim 24 is patentable over Kanazawa, Sullivan, and Silberschatz for at least the same reasons discussed above that claim 23 from which claim 24 depends is patentable over Kanazawa and Sullivan.

For at least the foregoing reasons, it is respectfully requested that the rejection of claim 24 under 35 USC 103(a) as being unpatentable over Kanazawa in view of Sullivan and Silberschatz be withdrawn.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

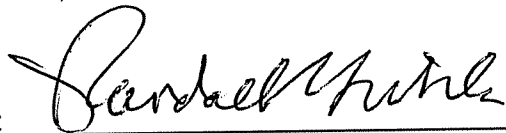
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

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Attachments